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U.S. Application No. 09/923,320 Examiner MARTIN Art Unit 2154
Response to January 27, 2005 Office Action

REMARKS

In response to the Office Action dated January 27, 2005, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. Assignee respectfully submits that the pending claims distinguish over the cited art of record.

The United States Patent and Trademark Office (the "Office") rejected claims 1-2, 7-13, 15-18, 20-24, 26-28, 30-37, 39-44, 46-51, and 55-57 under 35 U.S.C. § 102 (e) as being anticipated by Published United States Patent Application 2002/0046299 to Lefebvre *et al.* Claim 3 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2001/0051989 to Moncreiff. Claims 4, 19, and 29 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0028708 to Busch *et al.* Claim 5 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0111813 to Capps. Claims 6 and 52-54 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2004/0073507 to Scott. Claim 14 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0124100 to Adams. The Assignee shows, however, that the amended claims are patentably distinguishable over *Lefebvre*, *Moncreiff*, *Busch*, *Capps*, *Scott*, and/or *Adams*, whether considered singularly or in any combination.

Rejection of Claims under 35 U.S.C. § 102 (e)

The United States Patent and Trademark Office (the "Office") rejected claims 1-2, 7-13, 15-18, 20-24, 26-28, 30-37, 39-44, 46-51, and 55-57 under 35 U.S.C. § 102 (e) as being anticipated by Published United States Patent Application 2002/0046299 to Lefebvre *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). See also DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the amended claims are patentably distinguishable over *Lefebvre*. The reference to *Lefebvre*

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does not anticipate the claims, so the Assignee respectfully requests that Examiner Martin remove the 35 U.S.C. § 102 (e) rejection of the claims.

The pending claims have been amended. All the claims now recite methods, computers, or other systems that notify an offline user of an online user. As users log in to a website, the offline user's notification criteria are compared. The notification criteria specify a particular user that logs in to the website. When that particular user logs in, a notification is sent. A "clean" version of claim 1, for example, is reproduced below.

1. A method for notifying an offline user of an online user, the method comprising the steps of:

monitoring users who log in to a website;

as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and

when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user.

All the other independent claims include similar features.

Lefebvre does not anticipate the claims. As Examiner Martin noticed, *Lefebvre* is completely silent to monitoring users that log in to a website and sending a notification when a particular user that logs in to the website. Because *Lefebvre* fails to contemplate such features, the Assignee respectfully requests that Examiner Martin remove the 35 U.S.C. § 102 (e) rejection of the claims.

Rejection of Claim 3 under 35 U.S.C. § 103 (a)

Claim 3 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2001/0051989 to Moncreiff. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) the Examiner must identify "some suggestion or motivation...to modify the reference"; 2) the Examiner must identify "a reasonable expectation of success"; and 3) "the prior art reference must teach or

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suggest all the claim limitations.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). The Assignee shows, however, that the attempted combination of *Lefebber* and *Moncreiff* fails to teach or suggest all the features recited in the independent claims. The Assignee also shows that Examiner Martin has failed to properly present a *prima facie* case for obviousness. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

1. The *Prima Facie* Case of Obviousness Fails to Teach or Suggest All the Claimed Features

The independent claims are not obvious. All the independent claims recite methods, computers, or other systems that notify an offline user of an online user. As users log in to a website, the offline user’s notification criteria are compared. The notification criteria specify a particular user that logs in to the website. When that particular user logs in, a notification is sent.

The Examiner’s proposed combination of *Lefebber* and *Moncreiff* fails to teach or suggest such features. The proposed combination of *Lefebber* and *Moncreiff* is completely silent to the features recited in the independent claims. No where does *Lefebber* and/or *Moncreiff* teach or suggest: “monitoring users who log in to a website; as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user.”

Examiner Martin is correct — several times *Moncreiff* discusses the number of users in a chat room. See, e.g., Published United States Patent Application 2001/0051989 to Moncreiff (Dec. 13, 2001) at paragraphs [0009], [0045], [0050], [0057], [0058], and [0059]. No where, however, does *Moncreiff* monitor when a particular user logs in to a website and then send a notification that the particular user has logged in to the website. Examiner Martin points to paragraph [0003], but the Assignee finds no such teaching or suggestion. Paragraph [0003] reviews the basics of chat room use, such as “relaying” text between “occupants” of the chat

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room. Paragraph [0003] also describes how two users can arrange to “meet” in a private chat room for private conversation. Neither paragraph [0003], nor *Moncreiff in toto*, teach or suggest the features recited in the independent claims. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

Moncreiff is also silent to other features. Claim 3 also recites that the notification criteria further comprise “a request that the offline user log into the chat room, wherein the request is sent by a user logged into the chat room.” Examiner Martin points to paragraph [0012], yet, again, the Assignee finds no such teaching or suggestion. Paragraph [0012] discusses “keying” a website to a broadcast channel. Neither paragraph [0012], nor *Moncreiff in toto*, teach or suggest the features recited in claim 3. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

2. The *Prima Facie* Case of Obviousness Must Fail for Lack of Teaching, Suggestion, or Motivation

The Examiner’s attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). **When the motivation to combine the teachings is not apparent, the Examiner has a duty to explain why the combination is proper.** *See id.* at 2142; *see also In re Skinner*, 2 U.S.P.Q.2d (BNA) 1788 (Bd. Pat. App. & Inter. 1986) (emphasis added). **Even if the references teach all aspects of the claimed invention, the Examiner’s *prima facie* case must still include some objective reason to combine the references.** *See* M.P.E.P. at § 2143.01; *see also In re Levengood*, 28 U.S.P.Q.2d (BNA) 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added).

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Here, the office action fails to identify any teaching, suggestion, or motivation to combine the cited references. The Examiner makes no effort to explain why the proposed combination of *Lefebvre* and *Moncreiff* is proper. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to either i) supplement the rejection in the next office action or ii) remove the rejection. If the Examiner chooses to supplement the rejection in the next office action, that next office action cannot be made final without violating the Assignee's Due Process rights.

3. The *Prima Facie* Case of Obviousness Must Fail for Lack of Expectation of Success

The Examiner's attempted *prima facie* case for obviousness fails to establish any expectation of success. If the Office wishes to establish a *prima facie* case of obviousness, the Examiner must identify a reasonable expectation of success. See DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Here, the office action fails to identify any expectation of success. The Examiner makes no effort to explain why one of ordinary skill in the art would expect success when attempting to combine *Lefebvre* and *Moncreiff*. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claims 4, 19 & 29 under 35 U.S.C. § 103 (a)

Claims 4, 19, and 29 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0028708 to Busch *et al.* The Examiner's proposed combination of *Lefebvre* and *Busch*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Lefebvre* and/or *Busch* teach or suggest: "*monitoring users who log in to a website; as each user logs in, comparing notification*

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criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user." Examiner Martin points to paragraph [0039] of *Busch*, but the Assignee finds no such teaching or suggestion. Paragraph [0039] discusses inputting a username and password to log in to a gaming website. Neither paragraph [0039], nor *Busch in toto*, teach or suggest the features recited in claims 4, 19, and 29. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. As this response explains above, the Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. The Examiner's attempted *prima facie* case for obviousness also fails to establish any expectation of success. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claim 5 under 35 U.S.C. § 103 (a)

Claim 5 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0111813 to Capps. Claim 5, however, has been amended and no longer recites instant messaging features. Claim 5, instead, now recites notification criteria for an auction website. The rejection is now moot.

Rejection of Claims 6 & 52-54 under 35 U.S.C. § 103 (a)

Claims 6 and 52-54 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2004/0073507 to Scott. The Examiner's proposed combination of *Lefebvre* and *Scott*, however, again fails to teach or suggest the features recited in the independent claims. No where does *Lefebvre* and/or *Scott* teach or suggest: "*monitoring users who log in to a website; as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the*

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website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user." Neither *Lefebvre* nor *Scott* teach or suggest the features recited in claims 6 and 52-54. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. As this response explains above, the Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. The Examiner's attempted *prima facie* case for obviousness also fails to establish any expectation of success. Because the Examiner has failed to carry the initial burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

Rejection of Claim 14 under 35 U.S.C. § 103 (a)

Claim 14 was rejected under 35 U.S.C. § 103 (a) as being obvious over *Lefebvre* in view of Published United States Patent Application 2002/0124100 to Adams. The Examiner's proposed combination of *Lefebvre* and *Adams*, however, again fails to teach or suggest the features recited in the independent claims. Nowhere does *Lefebvre* and/or *Adams* teach or suggest: "*monitoring users who log in to a website; as each user logs in, comparing notification criteria of the offline user, the notification criteria specifying a particular user that logs in to the website; and when the particular user logs in to the website, sending a notification that the particular user has logged in to the website, the notification initiating an offline communication to the offline user."* Neither *Lefebvre* nor *Adams* teach or suggest the features recited in claim 14. The Assignee thus respectfully requests that Examiner Martin remove the § 103 (a) rejection.

The Examiner's *prima facie* case must fail for other reasons. As this response explains above, the Examiner's attempted *prima facie* case for obviousness fails to establish any teaching, suggestion, or motivation. The Examiner's attempted *prima facie* case for obviousness also fails to establish any expectation of success. Because the Examiner has failed to carry the initial

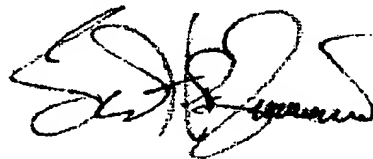
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burden of factually supporting the *prima facie* conclusion of obviousness, the Examiner is required to remove the rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

Scott P. Zimmerman
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